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[67190/984046]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

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In re Application of: : Examiner: Zeev Kitov
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BOURJRA et al. :
:
For: ELECTRONIC TRIPPING DEVICE :
COMPRISING CONTROL AND :
DISPLAY ELEMENTS :
:
Filed: February 1, 2001 :
: Art Unit 2836
:
Serial No.: 09/646,089 :
:
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MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Date:

23 Feb 2006

Signature:

Michelle Carniaux (Reg. No. 36,098)

REPLY BRIEF TRANSMITTAL

SIR:

Accompanying this Reply Brief Transmittal is a Reply Brief pursuant to 37 C.F.R. § 41.41 for filing in the above-identified patent application, together with two courtesy copies thereof.

While no fee is believed to be due, the Commissioner is authorized to charge, as necessary and/or appropriate, any additional and appropriate fees or credit any overpayment to Deposit Account No. 11-0600. A duplicate copy of this transmittal letter is enclosed for that purpose.

Respectfully submitted,

Michelle Carniaux (Reg. No. 36,098)

Dated: 23 Feb 2006

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REPLY BRIEF UNDER 37 C.F.R. § 41.41

SIR:

Appellants submit the present Reply Brief in response to the Answer dated December 23, 2005.

REMARKS

Claims 1 to 10 have been canceled.

Claims 11, 13, 14 and 19 to 22 stand finally rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,224,011 to Yalla et al. ("Yalla") in view of U.S. Patent No. 4,429,340 to Howell et al. ("Howell").

Claim 12 stands finally rejected under 35 U.S.C. § 103(a) as unpatentable over Yalla in view of Howell and further in view of U.S. Patent No. 5,852,643 to Dvorak et al. ("Dvorak").

Claims 15 and 16 stand finally rejected under 35 U.S.C. § 103(a) as unpatentable over Yalla in view of Howell and further in view of U.S. Patent No. 5,038,246 to Durivage et al. ("Durivage").

Claim 17 stands finally rejected under 35 U.S.C. § 103(a) as unpatentable over Yalla in view of Howell and further in view of Durivage and the case of *In re Stevens*.

Claim 18 stands finally rejected under 35 U.S.C. § 103(a) as unpatentable over Yalla in view of Howell and further in view of and the LCD element manufactured by the Kent company.

For at least the reasons set forth below and in the Appeal Brief, the rejections of claims 11 to 22 should be reversed.

As set forth in the Appeal Brief, it is Appellants' position that Yalla, Howell, Dvorak and Durivage, either alone or combined, do not disclose, or even suggest, an LCD display element for each of the tripping parameters to be adjusted for a tripping device, as recited in claims 19 and 21 (and included in claims 11 to 18, 20 and 22 by virtue of their dependency of either claim 19 or 21).

In the Examiner's Answer, it is asserted that LED bar graph displays 64 and 66 shown in Fig. 1 of the Howell reference are display elements visually displaying different tripping parameters of the system. However, such an assertion is inaccurate because the LED bar graph displays 64 and 66 do not display the tripping parameters of the system, but instead merely provide an indication of certain run-time aspects of the system. More specifically, "bar graph display 64 simply indicates the relationship of the largest phase current to the pickup level adjustably set into long-time pickup circuit 30", and bar graph display 66 indicates "the relationship of elapsed time to the duration of the long-time delay interval jointly determined by the overcurrent magnitude of the largest phase current and the setting of long-time band select circuit 56." Col. 5, lines 15 to 17 and 66 to 68. Accordingly, bar

graph displays 64 and 66 are not display elements that display each tripping parameter to be adjusted for a tripping device.

The Answer further asserts that it would have been obvious “to have modified the Yalla solution by adding LCD displays, one for each tripping parameter, according to Howell, *because as well known in the art, providing simultaneously more detailed information to the operator of the system would be beneficial for his performance*”, or that it would have been obvious “to have modified the Yalla et al. solution by using the bar displays according to Howell, *because it provides for a better visualization of the measured parameter and helps to get a visual information not only on an instant value of the measured parameter, but also on its current trend*”, or that it would have been obvious “to have modified the Yalla et al. solution by adding the third switch according to Dvorak, [or] by replacing the LCD element by the permanent display element from the Kent company, *because it will make possible to read the last readings of the device in the event of a power outage*”. Pages 4 to 7 of the Answer (Emphasis added). However, such assertions are clearly speculative suggestions by the Examiner, since no support whatsoever was provided for these otherwise conclusory statements. The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that if the Answer reflects a subjective “obvious to try” standard, it does not constitute proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original). Thus, the proper evidence of obviousness must show why there is a suggestion to combine the references so as to provide the subject matter of the claims and its benefits. Such showing is lacking in this Answer and the Office Actions.

In fact, the Office Actions to date and the Answer offer only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify the reference to provide the claimed subject matter and its benefits to address the problems met thereby, and it is respectfully submitted that the assertions to date in this regard are insufficient since the Office must provide proper evidence of a motivation or suggestion for modifying a reference to provide the claimed subject matter.

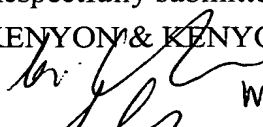
As further regards all of the obviousness rejections of the claims, it is respectfully submitted that not even a *prima facie* case has been made in the present case for obviousness, since the Office Actions to date never made any findings, such as, for example, regarding in any way whatsoever what a person having ordinary skill in the art would have been at the time the claimed subject matter of the present application was made. (See In re Rouffet, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998) (the “factual predicates underlying” a *prima facie* “obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art”)). It is respectfully submitted that the proper test for showing obviousness is what the “combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art”, and that the Patent Office must provide particular findings in this regard — the evidence for which does not include “broad conclusory statements standing alone”. (See In re Kotzab, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000) (citing In re Dembiczak, 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999) (obviousness rejections reversed where no findings were made “concerning the identification of the relevant art”, the “level of ordinary skill in the art” or “the nature of the problem to be solved”))). It is respectfully submitted that there has been no such showings by the Office Actions to date or by the Advisory Action.

In fact, the present lack of any of the required factual findings forces both Appellants and this Board to resort to unwarranted speculation to ascertain exactly what facts underlay the present obviousness rejections. The law mandates that the allocation of the proof burdens requires that the Patent Office provide the factual basis for rejecting a patent

application under 35 U.S.C. § 103. (See *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967))). In short, the Examiner bears the initial burden of presenting a proper prima facie unpatentability case — which has not been met in the present case. (See *In re Oetiker*, 977 F.2d 1443, 1445, 24, U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)).

Accordingly, for the foregoing reasons and for the reasons more fully set forth in the Appeal Brief, it is respectfully submitted that the final rejections of the pending claims should be reversed.

Dated: 23 Feb, 2006

Respectfully submitted,
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